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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/005,702 | 12/05/2001 | Jurgen Heinz Fabian | F7571(V) | 7656 |

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER

PADEN, CAROLYN A

| ART UNIT | PAPER NUMBER |
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1761

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,702

Applicant(s)

FABIAN ET AL.

Examiner

Carolyn A Paden

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Examiner had indicated to applicant that the claims were free of the prior art. But upon further consideration of the claims and all of the references, some of the claims are now rejected. Prosecution of the case on its merits continues.

Claims 10 and 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claim 10 includes the passive voice in the recitation "steps of emulsification of a fat phase". An amendment to the claims changing this phrase to -steps of emulsifying- would overcome the rejection.

Applicant proposed amending claim 12 to

-Process for preparing a foodstuff comprising shallow frying the emulsion of claim 1 to a desired temperature and then placing a foodstuff in the emulsion.- Support for this claim was found at page 12, lines 9-17.

This claim would be allowable if amended to include the substance of claim 1.

Claim 12 provides for the use of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Rainey et al (6,113,970) as further evidenced by Bauer-Plank (6,517,884) and Lissant.

Rainey discloses a food composition dispensed by spraying it. The composition contains 10-80 wt% oil and 1-5% lecithin (see abstract). The product is a water continuous emulsion that also contains xanthan gum and whey, which is a biopolymer. A second emulsifier is also used in the composition (column 1, lines 64-67). At column 3, lines 1-20, the second emulsifier is described to be polyoxy ethylene sorbitan monostearate. The pH of the emulsion is also shown to be pH 3.7 at column 2, line 43. Although the Bostwick value of the composition is not shown in the composition, the Bostwick value is known in the art to be a measure of how pourable the composition is and Bauer-Plank et al, at column 1, lines 59-65, is relied upon for support of this assertion. Since the composition of Rainey is a spray, one of ordinary skill in the art would have expected it to also be liquid. Thus, one of ordinary skill in the art, with the knowledge of what Bostwick values are, would have understood that the liquid composition of Rainey inherently possesses the Bostwick value of the claim. No antispattering composition is specifically described in Rainey,

but applicant defines salt and lecithin as an antispattering agent. Both of these ingredients are a part of the Rainey composition. Although the HLB value of polyoxyethylene sorbitan monostearate is not set forth in Rainey, the HLB value of the composition is well known in the art to be 14.9 (Lissant at page 266 is provided for support of this assertion). Although "frying composition" is not mentioned in the reference, the intended use of the composition does not alone carry any patentable weight in a product.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rainey as further evidenced by Bauer-Plank (6,517,884) and Lissant.

Rainey discloses a food composition dispensed by spraying it. The composition contains 10-80 wt% oil and 1-5% lecithin (see abstract). The product is a water continuous emulsion that also contains xanthan gum and whey, which is a biopolymer. A second emulsifier is also used in the composition (column 1, lines 64-67). At column 3, lines 1-20, the second

emulsifier is described to be polyoxy ethylene sorbitan monostearate. The pH of the emulsion is also shown to be pH 3.7 at column 2, line 43.

Although the Bostwick value of the composition is not shown in the composition, the Bostwick value is known in the art to be a measure of how pourable the composition is and Bauer-Plank et al, at column 1, lines 59-65, is relied upon for support of this assertion. Since the composition of Rainey is a spray, one of ordinary skill in the art would have expected it to also be liquid. Thus, one of ordinary skill in the art, with the knowledge of what Bostwick values are, would have understood that the liquid composition of Rainey inherently possesses the Bostwick value of the claim. No antispattering composition is specifically described in Rainey, but applicant defines salt and lecithin as an antispattering agent. Both of these ingredients are a part of the Rainey composition. Although the HLB value of polyoxyethylene sorbitan monostearate is not set forth in Rainey, the HLB value of the composition is well known in the art to be 14.9 (Lissant at page 266 is provided for support of this assertion). Although "frying composition" is not mentioned in the reference, the intended use of the composition does not alone carry any patentable weight in a product. Although DATEM is not particularly mentioned in Rainey, Rainey discloses

that any emulsifier would work in his invention. Thus the use of DATEM in the product of Rainey would have been an obvious emulsifier choice.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art to Bauer-Plank et al (6,517,884) shows a water in oil emulsion used for frying. This type of emulsion is the opposite of the claimed invention. The reference to McGee is cited to show the difference between a water in oil emulsion and an oil in water emulsion. The reference to Lissant is cited to show the HLB values of common emulsifiers and also to define what emulsifiers are useful in what water in oil versus oil in water emulsions.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is 703-308-3294. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


CAROLYN PADEN 8-29-03
PRIMARY EXAMINER
GROUP 1300-1761